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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,426	04/10/2006	Declan Patrick Kelly	NL031264	3750

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER	
HARVEY, DAVID E	

ART UNIT	PAPER NUMBER
2621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/575,426	KELLY, DECLAN PATRICK	
	Examiner	Art Unit	
	DAVID E. HARVEY	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 April 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/12/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 11 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A) Claims 11 and 12 are directed to a "record carrier". As defined in the instant specification, the "record carrier" terminology appears to be inclusive of a signal, per se **[SEE lines 30 and 31 of page 6]**. Signals, per se, are forms of energy and, as such, do not comprise statutory subject matter.

B) As noted above, claims 11 and 12 are directed to a "record carrier". Even if the recited "record carrier" terminology were defined/construed as being limited to a disc type recording medium, claims 11 and 12 still would not define statutory subject matter in view that the claims, at best, describe "nonfunctional descriptive material" that is recorded thereon. Nonfunctional descriptive material recorded on such a recording medium is non-statutory in that it is not a process, machine, manufacture, or composition of matter.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) With respect to claim 1 (and 2-7 which depend therefrom):

1) Claim 1 appears to be an apparatus claim and, as such, claim 1 must positively set forth "structure" which distinguishes the recited apparatus from the prior art. Lines 6-7 of claim 1 recite:

> **"characterized in that the event information is received from the playlist of the data stream".**

This recitation is confusing and/or indefinite because it is unclear how and/or if this recitation sets forth "structure" of the recited apparatus as is required of an apparatus claim. Clarification is needed.

B) With respect to claim 8:

1) Claim 8 appears to be an apparatus claim and, as such, claim 8 must positively set forth "structure" which distinguishes the recited apparatus from the prior art. Lines 4-5 of claim 8 recite:

> **"characterized in that the event information is received from the playlist of the video stream".**

This recitation is confusing and/or indefinite because it is unclear how and/or if this recitation sets forth "structure" of the recited apparatus as is required of an apparatus claim. Clarification is needed.

C) With respect to claim 9 (and claim 10 which depends there from):

1) Claim 9 appears to be a method claim and, as such, claim 9 must positively set forth the "active steps of manipulation" which distinguishes the recited method from the prior art. Lines 8-9 of claim 9 recite:

> **"characterized in that the event information is received from the playlist of the data stream".**

This recitation is confusing and/or indefinite because it is unclear how and/or if this recitation sets forth "active steps of manipulation" of the recited method as is required of a method claim. Clarification is needed.

D) With respect to claim 11:

1) Lines 3-4 of claim 11 recite:

"characterized in that the mark is reserved for use by an application".

It is unclear how and/or if this recitation defines the structure of the recited "record carrier". Clarification is needed.

E) With respect to claim 12:

1) Lines 3-4 of claim 12 recite:

"characterized in that the mark comprises further information for the application".

It is unclear how and/or if this recitation defines the structure of the recited "record carrier". Clarification is needed.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> **A person shall be entitled to a patent unless –**
>
> > **(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

6. Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #6,052,508 to Mincey et al for the same reasons that were set forth on the sixth page of the "written opinion of the international searching authority" (as submitted for consideration by applicant on 9/12/2007). More specifically:

A) The written opinion set forth the following position:

> ***"Claims 11 and 12 define that the playlist comprises a "mark" which is not defined either (Article 6 PCT). The claims merely describe that the mark is "for use by an application" or comprises "information for an application" which does not provide a clear explanation of the term "mark". Document D1 also discloses that an event in a playlist contains "mark in and mark out locations ... for a clip" (see col. 13, l. 24-45) such that the record carrier according to claims 11 and 12 is not even novel in the sense of Article 33(2) PCT".***

B) The instant examiner concurs:

> The instant examiner agrees with the search authority that instant claims 11 and 12 are so broadly written that they read on a conventional DVD record carrier having a playlist that includes "mark in" and mark out" information (as evidenced by Mincey et al.)

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Document #2003/0084441 to Hunt .

As is shown in Figure 1, Hunt illustrates an interactive TV system which functions as a "playback device" for playing (e.g., @ 16) and displaying (@ 20) and interactive video/data stream that is provided from an encoder (@ 12) wherein the device includes:

a) An encoder (@ 12) for providing the "***video/data stream***";

b) A recorder (@ 14) for recording the provided data stream on a "***record carrier***"; and

c) A "***playlist***" (@ 26) which is "***of the video/data stream***" in the sense that is used to provide a "ITV event" data that is used to generate the "***video/data stream***" (e.g., via the encoder (@ 12) **[Note paragraph 0008]**;

wherein the "ITV" data comprises "***Java or Java Script commands***" for execution on the receiver/display side (@ 20) of the device (i.e., wherein the receiver/display side must inherently comprise a "**Java processor**" running the appropriate Java application required to execute the "***Java or Java Script commands***".

8. Claims 2, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Document #2003/0084441 to Hunt for the same reasons that were set forth above for claim 1.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

10. Claims 1, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #6,052,508 to Mincey et al for the same reasons that were set forth on the sixth page of the "written opinion of the international searching authority" as submitted for consideration by applicant on 9/12/2007. More specifically:

A) The written opinion set forth the following position:

> ***"Claims 1, 8 and 9 refer to "event information" which is not defined and therefore renders the claims unclear (Article 6 PCT). Without an appropriate clarification, the subject-matter of said claims does not involve an inventive step in the sense of Article 33(3) PCT because the retrieving of event information form a playlist of a video stream is readily known from document D1 (see in particular col. 11, l. 66 - col. 13, l.45). Using a Java processor for processing an application based on the retrieved event information is well-known in the art for performing platform-independent processing of an application."***

B) The instant examiner concurs:

> The examiner agrees with the search authority that instant claims 1,8 and 9 are so broadly written that they read on a conventional Java processor (e.g., as evidenced by Mincey et al.) that is executing an application based on retrieved "event information" which retrieved "event information", the instant examiner agrees and take Official Notice, was notoriously well known in the art (i.e., given that "event information" has not been specifically defined and, as such, read on any retrieved information).

11. The following "prior art" is noted:

A) US Patent Document #2003/0063217 to Smith:

Smith has been cited because it described a device that is related to that described in US Patent Document #2003/0084441 to Hunt cited/applied above **[Note: Figure 1; and paragraph 0021].**

B) US Patent #7,346,920 to Lamkin et al.:

Lamkin et al. has been cited because it illustrates a DVD "record carrier" (e.g., @ 204 of Figure 2) which provided "event information" to a Java application being executed by a Java processor **[Note: lines 63-67 of column 6; lines 1-29 of column 7; lines 60-67 of column 28].**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY
Primary Examiner
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